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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,650	03/15/2001	Fumiyoshi Urano	910094RI	8670

7590 09/06/2002

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT¹

PAPER NUMBER

1626

44

DATE MAILED: 09/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

[illegible]

Office Action Summary	Application No. 09/810,650	Applicant(s) URANO ET AL.	
	Examiner Laura L. Stockton, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2002 and 31 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 is/are pending in the application.
- 4a) ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 07/646,909.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>43</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 7-9 are pending in the application.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/646,909, filed on January 28, 1991.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, the description requirements therein.

Specifically, in claim 8, the expression "wherein R¹ is a cyclic alkyl group in which the alkyl group is hexyl; and R² is a cyclic alkyl group in which the alkyl group is hexyl" lacks description as such in the original

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specification and the original claims. However, there is description in the instant specification of U.S. Pat. 5,216,135 (column 2, line 52) for bis(cyclohexylsulfonyl)diazomethane.

Specifically, in claim 9, the expression “where R^1 is a branched alkyl group in which the alkyl group is butyl; and R^2 is a branched alkyl group in which the alkyl group is butyl” lacks description as such in the original specification and the original claims. However, there is description in the instant specification of U.S. Pat. 5,216,135 (column 2, lines 55 and 56) for bis(tert-butylsulfonyl)diazomethane and bis(sec-butylsulfonyl)diazomethane.

Response to Arguments

Applicants' remarks concerning description for claims 8 and 9 have been considered. Applicants state that the written description is “clearly discernible”. However, Applicants have not pointed out where the claimed subject matter is described as such in the specification. Note the

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Examiner comments *supra* indicating what is described as such in the specification.

The Declaration by Albert Tockman dated May 30, 2002 has been considered. The Declaration is not found persuasive of any error by the Examiner as Declarant offers only his opinion as to matters relating to the Japanese priority document (JP 02-019614 filed January 30, 1990).

The Declaration provides no indication of description for the herein questioned claims 8 and 9 in the instant specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371⁹ of this title before the invention thereof by the applicant for patent.

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Claims 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Pawlowski et al. {U.S. Pat. 5,338,641}.

Pawlowski et al. disclose the compounds in column 4, lines 32, 33 and 46.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlowski et al. {U.S. Pat. 5,338,641}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim diazodisulfones. Pawlowski et al. teach diazodisulfones {e.g. α,α -bis(sulfonyl)diazomethanes} which are either

structurally the same as (see 102 rejection above) or structurally similar to the instant claimed compounds. See in the reference, for example, wherein R represents butyl (including positional isomers – e.g. *tert*-butyl) or cyclohexyl {column 3, lines 8-15, 40-49, 66-68 and column 4, lines 1-2 and especially the compounds in column 4, lines 32-34}.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that of generic description.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of “some” among “many” is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g. forms a strong acid on exposure to actinic radiation).

One skilled in the art would have been motivated to prepare compounds embraced by the reference genus to arrive at the instant claimed products with the expectation of obtaining additional beneficial compounds which would be useful in forming a strong acid on exposure to actinic radiation. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

Response to Arguments

202350-05907850
All of Applicants' arguments filed May 22, 2002 have been fully considered but they are not persuasive. Applicants argue Japanese priority document 02-019614 filed January 30, 1990 predates the earliest filing date of Pawlowski et al. and therefore, Pawlowski et al. is not prior art against those claims.

In response, the subject matter of claims 8 and 9 are not adequately described in the instant application much less the Japanese priority document. Note the decision by the Board of Appeals and Interferences on September 24, 1999 {Paper No. 27}, and especially claims 2 and 3, in

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Reexam 90/004812, which has been merged with the instant application, and the Judgment on February 1, 2001 by the United States Court of Appeals for the Federal Circuit {Paper No. 32}. A decision by the Court on claims 2 and 3 was not rendered since Applicants chose not to appeal the Board's decision of claims 2 and 3 to the Court. Therefore,

Applicants cannot rely on the filing date of the Japanese priority document and the rejection of the claims over Pawlowski et al. is proper.

Claim 7 is free of the art of record. Therefore, claim 7 is allowed.

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents **must** be submitted in response to this Office action.

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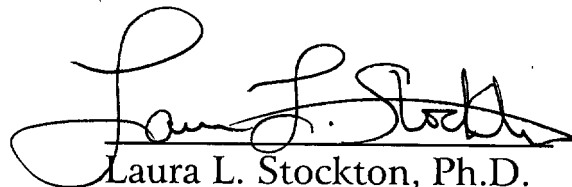
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Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, which will be strictly enforced.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone numbers for the organization where this application or proceeding is assigned is (703) 308-4556.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", with a horizontal line drawn underneath it.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

September 5, 2002